

**REMARKS/ARGUMENTS**

**I. Status of Claims and Formal Matters**

Claims 1-8 are pending in this application. Claims 1, 2, 4, 5, 6 and 8 are proposed to be amended. Claims 3 and 7 are canceled. Upon entry of the proposed amendments, claims 1, 2, 4, 5, 6, and 8 are pending and under active consideration. Applicant respectfully requests entry of the proposed amendments.

Claims 1, 2 and 4 are amended to correct grammatical and typographical errors.

Claim 5 is rewritten as a dependent claim and is amended to correct grammatical errors.

Claim 6 is amended to alter dependency.

Claim 8 is amended to alter dependency and to correct grammatical errors.

The specification is amended to correct typographical errors, to insert sequence identifiers and to capitalize reference to trademarks.

Support for each of the above amendments is provided by the specification as filed. Accordingly, no new matter is added by the proposed amendments.

## **II. Objections to the Specification and Claims**

### **A. Objections to the Specification**

At pages 2-3 of the Office Action, the Examiner objects to informalities in the specification. In particular, the Examiner points out typographical errors, omission of sequence identifiers and improper use of trademarks. Applicants herein amend the specification to correct these informalities and thank the Examiner for bringing them to their attention. Accordingly, Applicants request withdrawal of the objection.

### **B. Objections to the Claims**

At page 3 of the Office Action, the Examiner objects to claims 1 and 3 because abbreviations in the claims should be spelled out at their first occurrence in the claim set, followed by the abbreviation in parenthesis. Applicants herein cancel claim 3 and amend claim 1 as suggested by the Examiner. Accordingly, Applicants request withdrawal of the objections.

At page 4 of the Office Action, the Examiner objects to claim 6 as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Applicants herein amend claim 5 to refer to a first transposon according to claim 1 or 2 and a second transposon according to claim 4. Claim 6 is amended to specify that the first transposon is a transposon according to claim 2. Applicants respectfully submit that claims 5 and 6 as amended herein are compliant with MPEP 608.01(n). Applicant therefore requests withdrawal of the objections.

At page 4 of the Office Action, the Examiner objects to claim 8 because the claim contains numerous grammatical errors. In particular, the Examiner suggests that the phrase “to constructing a new mutant containing all chromosomal deletion sites of the above two mutant” be amended to recite “to construct a new mutant containing all chromosomal deletions sites of the above two mutants” and further suggests that the phrase “already prepare mutant” be replaced with “already prepared mutant.” Applicant thanks the Examiner for the suggestion and has amended claim 8 accordingly. Applicant therefore requests withdrawal of the objection.

### III. Patentability Arguments

#### A. Claim Rejections

##### 1) **The Rejections Under 35 U.S.C. § 112, Second Paragraph, Should be Withdrawn**

Claims 1 and 3 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants herein cancel claim 3 and amend claim 1 in a manner believed to overcome the rejections under this section. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1 and 3 under 35 U.S.C. 112, second paragraph.

##### 2) **The Rejections Under 35 U.S.C. 112, First Paragraph (Enablement), Should be Withdrawn**

Claims 7 and 8 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, according to the Examiner, claims 7 and 8 encompass the use of vectors (e.g. pKGloxP, pKKloxP) encompassed by the definitions for biological material set forth in 37 C.F.R. 1.801 and therefore must be obtainable by a reproducible method set forth in the specification or must be known and readily available to the public.

Applicants herein cancel claim 7 and amend claim 8 to depend only from claim 5 which does not refer to the vectors recited by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 7 and 8 under 35 U.S.C. 112, First Paragraph (enablement).

##### 3) **The Rejections Under 35 U.S.C. 103 Should be Withdrawn**

Claim 5 stands rejected under 35 U.S.C. § 103(a), as allegedly obvious over Yoon *et al.* (Genetic Analysis: Biomolecular Engineering, Vol. 14, pages 89-95 (1998)) in view of Bloch *et al.* (Biochemical and Biophysical Research Communication, Vol. 223, pages 104-111 (1996)).

Applicants, solely in the interest of expediting prosecution of the present application and without acknowledging agreement with the Examiner on this issue, herein amend claim 5 to refer to a first transposon according to claim 1 or 2 and a second transposon according to claim 4. Applicants respectfully submit that claim 5 as herein amended is nonobvious over the cited

references because the cited references, alone or in combination, do not teach or suggest transposons according to claim 1, 2 or 4 or their use in the method of claim 5. Accordingly, Applicants respectfully submit that the rejection of claim 5 may be properly withdrawn and hereby request withdrawal of the rejection of claim 5 under 35 U.S.C. 103(a).

Claim 8 stands rejected under 35 U.S.C. § 103(a), as allegedly obvious over Yoon *et al.* (Genetic Analysis: Biomolecular Engineering, Vol. 14, pages 89-95 (1998)) in view of Bloch *et al.* (Biochemical and Biophysical Research Communication, Vol. 223, pages 104-111 (1996)) as applied to claim 5 and further in view of Koob *et al.* (Annals of the New York Academy of Sciences, Vol. 745, pages 1-3 (1994)).

Applicants, solely in the interest of expediting prosecution of the present application and without acknowledging agreement with the Examiner on this issue, herein amend claim 8 to depend from claim 5, which, as discussed above, is nonobvious over Yoon and Bloch because the cited references, alone or in combination, do not teach or suggest transposons according to claim 1, 2 or 4 or their use in the method of claim 5. Because Koob *et al.* fails to rectify the aforementioned deficiencies of Yoon and Bloch, Applicants respectfully submit that the rejection of claim 8 may be properly withdrawn and hereby request withdrawal of the rejection of claim 8 under 35 U.S.C. 103(a).

Claim 3 stands rejected under 35 U.S.C. § 103(a), as allegedly obvious over Yoon *et al.* (Genetic Analysis: Biomolecular Engineering, Vol. 14, pages 89-95 (1998)) in view of Bloch *et al.* (Biochemical and Biophysical Research Communication, Vol. 223, pages 104-111 (1996)) as applied to claim 5 and further in view of Reznikoff *et al.* (WO 98/10077), Kilbride *et al.* (Journal of Molecular Biology, Vol. 289, pages 1219-1230 (1999)).

Applicants, solely in the interest of expediting prosecution of the present application and without acknowledging agreement with the Examiner on this issue, herein cancel claim 3. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 3 under 35 U.S.C. 103(a).

**CONCLUSION**

Applicants respectfully submit that the instant application is in good and proper order for allowance and early notification to this effect is solicited. The Examiner is hereby respectfully invited to contact the undersigned attorney at the telephone number listed below with any questions, comments, or suggestions relating to this application that may advance this application to allowance.

Respectfully submitted,  
HOWREY LLP

Dated: October 8, 2009

By: /David W. Clough/  
David W. Clough, Ph.D.  
Registration No.: 36,107  
Customer No.: 22930  
Telephone No.: (312) 595-1408

HOWREY LLP  
ATTN: Docketing Department  
2941 Fairview Park Drive, Suite 200  
Falls Church, VA 22042-2924  
Facsimile No.: (703) 336-6950